



**Kendrick, Mark R.**

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**From:** Patent Practice [PatentPractice@USPTO.GOV]  
**Sent:** Friday, December 03, 2004 10:16 AM  
**To:** Kendrick, Mark R.  
**Subject:** RE: Amendment Practice - Question

Dear Mr. Kendrick,

No complete claim listing is required when applicant is merely submitted arguments or an election in response to an office action. A claim listing is only required when amendments are being made to the claims. You may forward this email to the legal instruments examiner if you like. She can also contact our office directly by telephone if she has questions about 37 CFR 1.121. The number is 571-272-7703.

I hope this helps,

Ms. Terry J. Dey  
Office of Patent Legal Administration  
Deputy Commissioner for  
Patent Examination Policy  
United States Patent and Trademark Office

-----Original Message-----

**From:** Kendrick, Mark R. [mailto:mkendrick@pillsburywinthrop.com]  
**Sent:** Thursday, December 02, 2004 2:16 PM  
**To:** Patent Practice  
**Subject:** RE: Amendment Practice - Question

Dear Ms. Dey,

Thank you for your assistance.

The application number is 10/722,254 (the application is Muraki and the Filing Date is 11/25/03). I did not provide it in the first place because I did not want to seem confrontational to the Legal Instruments Examiner. I just wanted to make sure I understood the rule.

Mark

-----Original Message-----

**From:** Patent Practice [mailto:PatentPractice@USPTO.GOV]  
**Sent:** Thursday, December 02, 2004 11:06 AM  
**To:** Kendrick, Mark R.  
**Subject:** RE: Amendment Practice - Question

Thank you for your inquiry.

Please provide the application number so that we may look into this matter.

Ms. Terry J. Dey

Office of Patent Legal Administration  
Deputy Commissioner for  
Patent Examination Policy  
United States Patent and Trademark Office

-----Original Message-----

**From:** Kendrick, Mark R. [mailto:mkendrick@pillsburywinthrop.com]  
**Sent:** Thursday, December 02, 2004 12:46 PM  
**To:** Patent Practice  
**Subject:** Amendment Practice - Question

Message Directed to Gena Jones, Joe Narcavage, and Elizabeth Dougherty:

I am a patent attorney. On a case that we are responsible for, we filed a response with no amendment to the claims. The response was labeled as a "Response." According to our reading of the change in amendment practice, if we do not make amendments to the claims, then we do not have to list or set forth the claims in the response (and thus we did not). The Legal Instruments Examiner said we filed a non-compliant amendment because in the "Remarks" section of our response, we set forth a claim (in order to distinguish it over the prior art) and thus we should have listed all of the claims.

Please help me clear this up and tell us what the proper rules are.

Mark Kendrick  
Reg. No. 48,468

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